Remarks

This Amendment is in response to the Final Office Action dated July 6, 2005. This amendment is to be formally entered in connection with the RCE filed on September 23, 2005. Claims 1-5 remain pending. Claims 6-13 have been canceled as non-elected claims.

1. 35 USC 103(a) Rejections

The Office Action has rejected claims 1-5 under 35 U.S.C. § 103(a) as being unpatentable over Tsuchiya et al ('872). The Office Action has rejected claims 1-5 under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Inoue (652) and Tsaur. The Office Action has rejected claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Inoue et al (672) and Tsaur. The Office Action has rejected claims 1-5 under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Sasaki and Tsaur.

The applicant has amended the claims in light of the Examiner's comments and has included specific amounts of HEC and PEO into the claims. It is submitted that the claim amendments meets the concerns raised in the Office Action. The references neither disclose a polishing composition as recited in claim 1, as amended, nor teach or suggest that a polishing composition containing both HEC and PEO with the specified average molecular weight in the specified amounts is effective to reduce haze levels on wafers. It is respectfully submitted that the claims as amended are not obvious over the cited references.

Withdrawal of the rejections is respectfully requested.

2. Double Patenting Rejections

The Office Action has provisionally rejected claims 1-5 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all of the claims of co-pending application 10/673,779, and also over claims 1-10 of co-pending application 10/673,767. Because the three applications are for distinctly different inventions, applicant filed three separate applications on the same day to avoid burdening the examiner with the need to issue a restriction requirement. These differences are also the reason why the double patenting rejection was in error.

Judicially created double patenting rejections are improper when the rejected claims are patentably distinct. Eli Lilly & Co. v. Barr Labs., Inc., 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001); Ex parte Davis, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000). Proving claims are patently distinct in response to obvious type double patenting rejections is done by proving non-obviousness. In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

As explained in Section 2 of the remarks, this invention is not obvious in light of an invention that merely mentions water soluble polymers. Only a claim specifically mentioning combining HEC and PEO would address the non-obvious unexpected and superior haze reducing effects this mixture produces. 10/673,779 describes a wafer surface polisher and 10/673,767 describes a wafer edge polisher. Both applications claim a water soluble polymer but say nothing about mixing HEC and PEO. Their use of the term water soluble polymer does not suggest or teach that the simultaneous use of HEC and PEO is particularly effective for reducing haze level of a wafer surface and do not disclose the unexpected and superior combined effects. As a result, the double patenting rejections should be withdrawn. For at least these reasons, it is not necessary to file a terminal disclaimer at this time.

Withdrawal of the rejection is respectfully requested.

Conclusion

For the reasons stated above, applicant believes claims 1- 5 are allowable. Applicant respectfully requests notification to that effect.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: December 14, 2005

By: _____
Scott Q. Vidas
Registration No.: 30,812

6109 Blue Circle Drive, Suite 2000
Minnetonka, MN 55343-9185
Telephone: (952) 563-3000
Facsimile: (952) 563-3001

f:\wpwork\sqv\11333us01_amd_20051214.doc